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OFFICE OF PETITIONS

In re Application	:
Venkatraman, et al.	:
Application No. 09/836,636	: DECISION ON APPLICATION
Filed: April 17, 2001	: FOR PATENT TERM ADJUSTMENT
Atty Docket No. IN01155K	:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 C.F.R. § 1.705)(b)", filed March 23, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred thirty-two (132) days to four hundred six (406) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein. However, applicants' request that an additional PTO delay of one hundred fifty-seven (157) days be assessed is being **HELD IN ABEYANCE** until after the actual patent date.

Applicants are given two months from the issue date of the patent to request reconsideration of the patent term adjustment indicated on the patent application. Applicants may seek such reconsideration without payment of the fee. A copy of this decision should accompany applicant's written request for reconsideration.

On March 10, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is one hundred thirty-two (132) days. On March 23, 2004, applicants timely¹ submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is four hundred six (406) days.

Applicants specifically states that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of one hundred thirty-two (132) days based on an adjustment for PTO delay of one hundred sixty-six (166) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(2), reduced by applicants' delay of thirty-four (34) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b). Applicants' delay of 34 days has been reviewed and found to be correct. The adjustment of one hundred sixty-six (166) days is at issue.

A review of the application file reveals that the Office mailed a Restriction Requirement on February 19, 2002. Applicants timely filed an Election on March 26, 2002. However, the Office mailed a Notice of Non-Complaint Amendment on April 10, 2002. Applicants filed a proper reply on April 29, 2002, and pursuant to 37 C.F.R. § 1.704(c)(7), were properly assessed applicant delay of thirty-four (34) days.

Pursuant to 37 C.F.R. § 1.703(a)(2), the Office had four months, or until August 29, 2002, to mail either an action under 35 U.S.C. 132 or a Notice of Allowance. The Office mailed a "Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures" (hereinafter "Sequence Notice") on February 11, 2003, and was improperly assessed PTO delay of one hundred sixty-six (166) days. The Office has stated that a Sequence Notice is **not** an action under 35 U.S.C. 132.² The Office did not mail an action under 35 U.S.C. 132 until May 5, 2003. Accordingly, PTO delay should have been assessed as two hundred forty-nine (249) days, not one hundred sixty-six (166) days.

¹ PALM records indicate that applicants paid the issue fee on March 31, 2004.

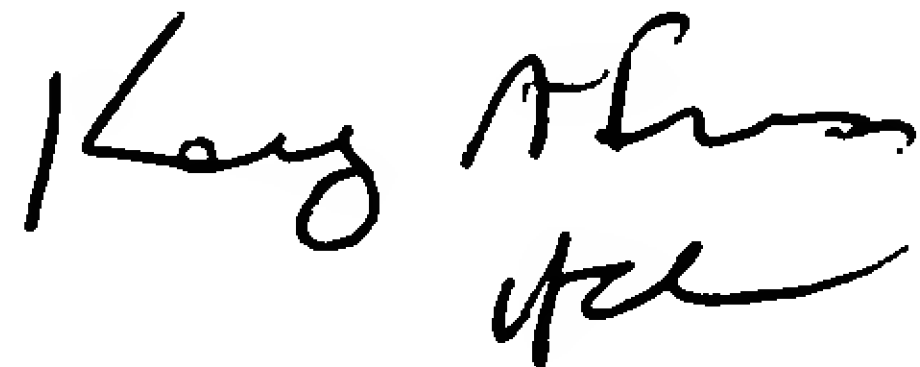
² See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 1239 OG 14 (Oct. 3 2000).

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **two hundred fifteen (215) days** (249 days of PTO delay reduced by 34 days of applicant delay).

The \$200.00 fee set forth in 37 C.F.R. \$1.18(e) has been charged to Deposit Account No. 19-0365, as authorized.

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.



Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen

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IN01155K

MAR 23 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICIAL

In re Application of:

S. Venkatraman et al.

Serial No.: 09/836,636

Filed: April 17, 2001

For: "Macrocyclic NS3-Serine Protease:
Inhibitors of Hepatitis C Virus
Comprising Alkyl and Aryl
Alanine P2 Moieties"

Examiner: D. Lukton

Group Art Unit: 1653

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450
Mail Stop: Petition**APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST
FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED
IN NOTICE OF ALLOWANCE (37 C.F.R. § 1.705)(b)**

Sir:

1. This is a request for reconsideration of the patent term adjustment of 132 days indicated in the Determination of Patent Term Adjustment Under 35 U.S.C. §154(b) that was attached to the Notice of Allowance mailed on March 10, 2004 in the present case. It is respectfully submitted that Applicants be afforded a patent term adjustment of 406 days.
2. The issue fee has not yet been paid.
3. Applicants submit herewith a "Statement of the Correct Patent Term Adjustment: Grounds Under 37 C.F.R. § 1.702 For the Adjustment" (37 C.F.R. § 1.705 (b) (2)(i) and (ii)).
4. Any patent granted on this application (37 C.F.R. § 1.705 (b) (2)(iii)) is not subject to a terminal disclaimer.
5. As to circumstances during the prosecution of this application constituting a failure to engage in reasonable efforts to conclude processing

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